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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,165	06/08/2005	Hiroyuki Hidaka	81887.0124	9232
26/021 7590 05/27/2009 HOGAN & HARTSON LLP. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067				
EXAMINER				
SANTILAGO CORDERO, MARIVELISSE				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
05/27/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/538,165

**Applicant(s)**

HIDAKA, HIROYUKI

**Examiner**MARIVELISSE SANTIAGO-  
CORDERO**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 4, 7 and 8 is/are pending in the application.  
4a) Of the above claim(s) 1, 2, 5, 6, 9 and 10 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 3, 4, 7 and 8 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 03 October 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/2009 has been entered.

***Specification***

2. The amendment filed on 5/12/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: rephrasing page 7, lines 16-18 under the Brief Description of the Drawings section to delete Fig. 3C from the original disclosure that stated that Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a conventional suspend time introduces new matter into the disclosure as originally filed. Although a rewording (rephrasing) of a passage where the same meaning remains intact is permissible, the exclusion of Fig. 3C from the figures that were admitted as being conventional in the originally filed specification, changes the meaning of the passage, the scope of what was originally disclosed is altered and, therefore, constitutes a new matter into the specification. Applicant is required to cancel the new matter in the reply to this Office Action.

***Response to Arguments***

3. Applicant's arguments filed on 5/12/2009 have been fully considered but they are not persuasive.

Regarding the drawings, Applicant argues that Figure 3C is not prior art because Figure 3C is an example of a case in which the guard time is not set (Remarks: page 7, under "Drawings"). In response, the Examiner respectfully disagrees. Applicant's specification (page 7), under the "Brief Description of the Drawings" section, clearly stipulates that "Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a conventional suspend time", thus, considered an admission or prior art. Consequently, Figure 3C should be labeled with --Prior Art-- because only that which is old is illustrated. Although Applicant amended the specification by indicating that Fig. 3C is a timing chart of a case where a suspend time is not set, the exclusion of Fig. 3C from the figures that were admitted as being conventional in the originally filed specification introduces new matter into the originally filed specification as explained above. Therefore, Fig. 3C, as originally filed, in conjunction with Figures 3A and 3B are timing charts showing processing performed in the 1xEVDO system during a conventional suspend time. Accordingly, as admitted by applicant in the originally filed specification, Fig. 3C is an admission of prior art. Consequently, the objection to the drawings is maintained, i.e., Fig. 3C should be labeled with --Prior Art-- because only that which is old is illustrated.

Regarding the rejections, Applicant's arguments are moot in view of the new grounds of rejection. However, given that some of the references are still used in the rejection, the following response is submitted.

Applicant argues that Applicant's Admitted Prior Art (AAPA) cannot anticipate or render claim 3 obvious because as discussed above and as clarified by the amendment to the specification, Fig. 3C, which the Examiner relied upon in the rejection, is NOT Prior Art, since Fig. 3C represents a timing chart of a case where a suspend time is not set and, therefore, the case in which a suspend time is not set is not Prior Art (Remarks: page 8, 2nd full paragraph). In response, the Examiner respectfully disagrees. As explained above, rephrasing page 7, lines 16-18 under the Brief Description of the Drawings section to delete Fig. 3C from the original disclosure that stated that Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a conventional suspend time introduces new matter into the disclosure as originally filed. That is, excluding Fig. 3C from the figures that were admitted as being conventional in the originally filed specification introduces new matter into the specification. Therefore, Fig. 3C, as originally filed, in conjunction with Figures 3A and 3B are timing charts showing processing performed in the 1xEVDO system during a conventional suspend time. Consequently, as admitted by applicant in the originally filed specification, Fig. 3C is an admission of prior art. Furthermore, page 13, lines 12-13 of the originally filed specification states that Figs. 3A to 3C show timing charts of communication using the suspend time in the 1xEVDO system; therefore, an admission that, in the 1xEVDO system, the suspend time is used as shown in Figs. 3A to 3C.

#### ***Drawings***

4. Figure 3C should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (See *Response to Arguments* section above). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office

action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

5. Claim 3 and its dependents thereof are objected to because of the following informalities: the term "the first communication method" (claim 3, line 15) should be replaced with --the first communication protocol-- in order to be consistent with claim terminology. Appropriate correction is required.

6. Claim 7 and its dependents thereof are objected to because of the following informalities: the term "the first communication method" (claim 7, line 9) should be replaced with --the first communication protocol-- in order to be consistent with claim terminology. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 3-4 and 7-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 3, 7, and their dependents thereof, the newly added limitations of "wherein the setting section does not the suspend time after the second changing section changes the monitoring timing of the first communication method by communicating with the base station" (Claim 3) and "not setting the suspend time for detecting an incoming call from the base station using the first communication protocol after the monitoring timing of the first communication method is changed by communicating with the base station" were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does disclose wherein the setting section does not set the suspend time in a case of communicating with the base station by the second changing section (page 5, lines 19-22); and that the suspend time is not set when the processing for communication with the base station has ended properly (page 17, line 24 through page 18, line 1). However, this is different from the specific limitation of not setting the suspend time after the second changing section changes the monitoring timing of the first communication method as claimed. Applicant has not pointed out where the amended claim is supported, nor does there appear to be a written description of the claim limitation of not setting the suspend time after the second changing section changes the monitoring timing of the first communication method as claimed in the application as filed.

Applicant is welcomed to point out where in the specification the Examiner can find support for this limitation if applicant believes otherwise.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter "AAPA").

Regarding claim 3, AAPA discloses a wireless communication terminal (Background Art: page 1, line 25 through page 2, line 7), which performs wireless communication using each of a first communication protocol and a second communication protocol (Background Art: page 1, line 25 through page 2, line 7; note the 1xEVDO and CDMA2000 1x, respectively) and enables to be in an idle state with both protocol (Background Art: page 2, lines 17-24), comprising:

a setting section that sets a suspend time (Figs. 3A-3B and 4; note that this figures are Prior Art) for detecting an incoming call from a base station (Figs. 3B and 4; note the "page") using the first communication protocol (Fig. 3B and 4; note the 1xEVDO) subsequent to completion of communication with the base station using the first communication protocol (Background Art: page 3, lines 4-11; page 12, lines 12-25; note that this section constitutes an admitted prior art statement since only that which is old and/or known is disclosed);

a first changing section that changes a monitoring timing of the second communication protocol (Fig. 4; Background Art: page 2, lines 8-24; page 16, line 18 through page 17, line 3;



note that as a result of an idle handoff in the CDMA2000 1x system (the second communication protocol) the timing of system monitoring may change); and

a second changing section that changes a monitoring timing of the first communication protocol by communicating with the base station when the first changing section changes the monitoring timing of the second communication protocol (Fig. 4; Background Art: page 2, lines 8-24; page 16, line 18 through page 17, line 3; note that as a result of an idle handoff in the CDMA2000 1x system (the second communication protocol) the timing of system monitoring may change; and in this case, the timing of monitoring the 1xEVDO system (the first communication protocol) must be changed).

AAPA's embodiment discussed above (i.e., Figs. 3A-3B and 4) fail to specifically disclose wherein the setting section does not set the suspend time after the second changing section changes the monitoring timing of the first communication method.

In the alternate embodiment of Fig. 3C, which as explained above constitutes an admission of prior art, it is shown a timing chart of a case where a suspend time is not set. That is, AAPA discloses wherein the setting section does not set the suspend time (Fig. 3C; page 14, lines 11-12; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed).

Furthermore, AAPA's Figure 4 shows that after the second changing section changes the monitoring timing of the first communication method, the 1xEVDO system is in the active state. Figs. 3A-3C show conventional timing charts showing processing performed in the 1xEVDO system (see page 7, lines 16-18 of original specification and *Response to Arguments* section

above). Note that all of the timing charts of figures 3A to 3C commence in the active state (i.e., "comm" state).

One of ordinary skill in this art at the time of invention by applicant, being given AAPA's Figures 3A to 3C and 4, would reasonably recognize that any of the situations presented in Figures 3A to 3C would apply after the 1xEVDO system is in the active state, which occurs, according to figure 4, after the second changing section changes the monitoring timing of the first communication method.

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to, after the second changing section changes the monitoring timing of the first communication method of AAPA Figure 4, not set the suspend time as suggested by AAPA's Figure 3C for the advantages of performing any conventional processing performed in the 1xEVDO system (see page 7, lines 16-18 of original specification and Response to Arguments section above) and immediately shifting to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power.

Regarding claim 4, AAPA discloses the wireless communication terminal according to claim 3 (see above), wherein the first communication protocol is a 1x Evolution Data Only system (Fig. 4; (Background Art: page 1, line 25 through page 2, line 7) and the second communication protocol is a Code Division Multiple Access 2000 1x system (Fig. 4; (Background Art: page 1, line 25 through page 2, line 7).

Regarding claims 7-8, which recites a method version of claims 3-4, see rationale as discussed above, i.e., claims 7-8 are rejected with the same grounds and for the same reasons/motivations explained above.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIVELISSE SANTIAGO-CORDERO whose telephone number is (571)272-7839. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent P. Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARIVELISSE SANTIAGO-CORDERO/  
Examiner, Art Unit 2617